

REMARKS

I. Introduction

With the addition herein of claim 27, claims 14 to 27 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable. Reconsideration is respectfully requested.

II. Rejection of Claims 14 to 16, 18 to 20, 23 and 24 Under 35 U.S.C. § 102(b)

Claims 14 to 16, 18 to 20, 23 and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,662,255 (“Garrett”). For at least the following reasons, Applicants respectfully submit that Garrett does not anticipate the presently pending claims.

Claim 14, as presented, relates to a hand-held locating device for detecting an object enclosed in a medium, comprising, in relevant part, a housing having an opening penetrating therethrough, the opening configured in size to guide a device for marking a surface of the medium. Support for this amendment may be found, for example, at page 3, lines 12 to 28 of the Specification. As indicated in the Specification on page 3, the opening may be used, for example, to guide a pencil or similar marking systems for a marking to be left on the surface of the medium to be examined. While Applicants do not agree with the rejection, to facilitate matters, claim 14 has been amended herein to more specifically claim the structure of the opening in the housing of claim 14. Garrett does not disclose, or even suggest, an opening configured in size to guide a device for marking a surface of a medium.

The Final Office Action refers to items 32, 32a and 50a of Figures 1 and 9 of Garrett as disclosing this feature. It is evident from Figure 1 of Garrett, however, that the space within the outer inductor assembly 32 of Garrett is not configured in size to guide a marking device. The space is relatively large, and would not support any reasonable level of accurate marking. In fact, Garrett lacks any indication that the disclosed device would be useful in marking a medium.

Claim 14 further features a handle attached to the housing, the handle situated in close proximity to the housing so as to permit an operator to grasp the handle while operating the device for marking a surface of the medium. Support for this amendment may be found, for example, at page 7, lines 1 to 7, and page 8, line 21 to page 9, line 8, as well as Figure 1. The outer inductor assembly of Garrett is located at a relatively great distance from the hand-held portion of the device. A user would not be able to both hold the device and mark the surface of the medium. As discussed above, Garrett lacks any indication that the

disclosed device would be useful in marking a medium. For this point, the situation of the outer conductor assembly is further support.

Garrett does not disclose, or even suggest, an opening that is configured in size to guide a device for marking a surface of the medium, and a handle attached to the housing, the handle situated in close proximity to the housing so as to permit an operator to grasp the handle while operating the device for marking a surface of the medium. As such, Garrett does not disclose, or even suggest, each and every feature of claim 14, as presented, and therefore Garrett does not anticipate claim 14.

Claims 15, 16, 18 to 20, 23 and 24 depend from claim 14 and therefore include all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, each and every feature of claim 14, as presented. As such, Garrett does not anticipate independent claim 14 or dependent claims 15, 16, 18 to 20, 23 and 24.

Withdrawal of the present rejection is respectfully requested.

III. Rejection of Claims 14 and 26 Under 35 U.S.C. § 102(e)

Claims 14 and 26 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2006/0062472 (“Engelberg”). For at least the following reasons, Applicants respectfully submit that Engelberg does not anticipate the presently pending claims.

Engelberg does not disclose, or even suggest, an opening, penetrating through a housing, configured in size to guide a device for marking a surface of a medium. The Final Office Action refers to a vehicle as the housing of the present application, and to the interior compartment of the vehicle as an opening. The interior compartment of the vehicle, however, is not configured in size to guide a device for marking a surface of the medium being examined. The Final Office Action, in the response to arguments, indicates that the interior compartment accommodates a device for marking because it is large enough to fit a marker or pencil. While Applicants do not agree with the rejection, claim 14 has been amended herein, without prejudice. The size of the interior compartment offers no guidance to a device for marking a surface of a medium. Further, Engelberg lacks any indication that the disclosed device would be useful in marking a medium.

Further, the Office Action refers to the compartment as disclosure of the opening of claim 14 and the vehicle as the housing of claim 14 while referring to the interior of the vehicle as the medium of claim 14. This would imply that the present application is directed towards the location of objects within the opening. The medium being examined

and the opening featured in claim 14 are not the same item, and should not be treated as such. Claim 14 has been amended herein, without prejudice, to reflect this aspect of the present application. Support for this amendment may be found, for example, at page 7, lines 1 to 7, as well as Figure 1.

Finally, regarding the Final Office Action's assertion that a vehicle having door handles and a steering wheel is hand-held, no person of ordinary skill in the art would consider a vehicle to be a hand-held device.

Engleberg does not disclose, or even suggest, each and every feature of claim 14, as presented. Therefore, Engelberg does not anticipate claim 14.

Claim 26 depends from claim 14 and therefore includes all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Engelberg does not disclose, or even suggest, all of the features of claim 14, and therefore does not anticipate independent claim 14 or dependent claim 26.

Withdrawal of the present rejection is respectfully requested.

IV. Rejection of Claim 17 Under 35 U.S.C. § 103(a)

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 4,859,931 ("Yamashita"). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Yamashita does not render unpatentable claim 17.

Claim 17 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Yamashita does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Yamashita does not disclose or suggest all of the features of independent claim 14 or dependent claim 17, and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is respectfully requested.

V. Rejection of Claims 21 and 22 Under 35 U.S.C. § 103(a)

Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 6,266,006 ("Audet"). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Audet does not render unpatentable claims 21 and 22.

Claims 21 and 22 depend from claim 14 and therefore incorporate all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett

does not disclose, or even suggest, all of the features of claim 14. Audet does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Audet does not disclose or suggest all of the features of independent claim 14 or dependent claims 21 and 22, and therefore does not render unpatentable the presently pending claims.

Withdrawal of the present rejection is respectfully requested.

VI. Rejection of Claim 25 Under 35 U.S.C. § 103(a)

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 6,844,713 (“Steber”). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Steber does not render unpatentable claim 25.

Claim 25 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Steber does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Steber does not disclose or suggest all of the features of independent claim 14 or dependent claim 25 and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is respectfully requested.

VII. New Claim 27

New claim 27 has been added herein. It is respectfully submitted that claim 27 adds no new matter and is fully supported by the present application, including the Specification. Claim 27 includes all of the features of claim 14, as presented, and therefore it is respectfully submitted that claim 27 is patentable over the references relied upon for at least the reason set forth above with respect to claim 14.

VIII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: March 23, 2009

By: /Clifford A. Ulrich/
Clifford A. Ulrich, Reg. No. 42,194 for
Gerard A. Messina (Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646